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10/780,062	02/17/2004	Calvin Lam	C&M1.PAU.19	9669
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MYERS DAWES ANDRAS & SHERMAN, LLP			FONSECA, JESSIE T	
19900 MACARTHUR BLVD.				
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IRVINE, CA 92612			3633	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/780,062	LAM, CALVIN	
	<b>Examiner</b>	<b>Art Unit</b>	
	JESSIE FONSECA	3633	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 28 July 2008.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 7,10,12,13,15-17 and 20-28 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 7,10,12,13,15-17 and 20-28 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 28 July 2008 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____.	6) <input type="checkbox"/> Other: _____ .



## DETAILED ACTION

### *Drawings*

The drawings were received on 7/28/08. These drawings are not acceptable as proposed figure 9 does not include joint lines. Note figure 8 includes joint lines along the top face; therefore the joint lines should be present on the front face of the slats found in figure 9.

As the drawings have not been entered, the previous objections to the drawings are reiterated below.

The drawings are objected for the following:

- Figure 5: The inclusion of vertical solid lines on the front and rear outer faces implies the zigzag joints are angled along those faces. It is noted that in fig. 6, the front and rear faces are planar in which no vertical solid lines are present. Furthermore, the hidden lines representing zigzag shapes are not properly drawn as the various block sections would not engage one another properly; the top rear portion of the zigzag shapes should meet the corner of the respective block sections. Further, as hidden lines are implemented in the figure, a hidden line should also be drawn to represent the rear bottom face.
- Figures 4 and 5 require bracketing “}”.
- Figure 6, 9 and 10 fail to show the lines of the joints which would be visible on the top. Furthermore, it's unclear to what the three dots to the right of figure 9 represent.

- Figure 8 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Further, it is unclear why Figure 8 is even necessary as it appears to be identical to Figure 7 which is indicated as "Prior Art".

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

Claims 20 and 21 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 20 requires that the second planes are perpendicular to the first planes. Claim 20 depends from claim 7, which requires the second plane to be transverse to the first planes. The examiner fails to see how claim 20 further limits claim 7 from which it depends. Similarly claims 21 indirectly depends from claim 13 which requires the second planes transverse the first planes. Note Merriam-Webster Dictionary defines transverse as: *1 : acting, lying, or being across : set crosswise 2 : made at right angles to the long axis of the body <a transverse section>*.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 8, 10, 12, 13, 15 and 23-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification fails to adequately describe / enable substantially unnoticeable joining marks.

The specification states that the additional processing steps hide the joining marks 32. The examiner disagrees. Joining marks 32 would appear along the top face of the block of Figure 9 as well as the faces of the slats of Figure 10 (Note they would also appear along the top face of the Prior Art block in Figure 6). The additional steps or rejoining and cutting it at a transverse plane cannot hide these joints. The joints will remain. They will appear as straight lines rather than in a zigzag finger joint pattern but they will still be visible and not unnoticeable (substantially hidden) as described and claimed.

Furthermore, the specification lacks adequate disclosure as to why it necessary to join slats in an order different than the first order. The specification states that rejoining each of the wood pieces in a different order would hide the joining marks to form a new bulk section. Examiner fails to see how the step of the bulk section being cut into slats and rearranged is necessary, as it would still result in zigzag and straight line joining marks across the respective faces. If one were to rearrange the wood slats so as to vary the wood pattern, the joint lines would be accentuated as a break in the wood pattern, thus making the joining marks noticeable.

Note: claims 8, 10, 12, 13, 15 and 23-28 are examined as best understood.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7, 10, 12-13, 15-17, and 20-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's prior art disclosure (par. 0006 -0008) in view of Kertscher (US 947,001).

With regards to claim 7: Applicant discloses a prior art method for making a wood slat, the method comprising:

providing a first bulk section (30) of wood having joining marks (32) that appear in a face plane, the joining marks (32) resulting from rejoining shorter blocks (8) of wood to form the bulk section (30) (fig. 5-6; par. 0006-0007); and

cutting the first bulk section along first parallel planes in a successive first order to form a plurality of first slats each having a face plane (figs. 6-7; par. 0008).

Applicant discloses everything previously mentioned except for joining the face planes of the first slats in an order different than the first order to create a new bulk section in the form of a laminate; and cutting the new bulk section along second parallel planes to form the wood slat, the second parallel planes being generally transverse to the first parallel planes such that the joining marks are substantially unnoticeable in the wood slat.

However, Kertscher discloses cutting a bulk section along first parallel planes to form slats and joining the slats to create a new bulk section in the form of a laminate (figs. 1 & 3; col. 2, lines 64-68; col. 4, lines 88-100). Kertscher further discloses cutting the new bulk section along second planes generally transverse plane in order to create a desired grain pattern (figs. 1 & 3; col. 4, lines 84-109).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the applicant's prior art method to further include the step joining the slats to create a new bulk section in the form of a laminate, in which the laminate is then cut along second parallel planes generally transverse to the first parallel planes as taught Kertscher in order to create a desired grain pattern.

No new or unpredictable results would be expected from joining the face planes of the first slats in an order different than the first order so as to create a new bulk section in the form of a laminate. The first slats are identically cut, therefore rearranging that slats in a different order from which they were cut would not be expected be to hide the joining marks as discussed in par. 0015 of specification. As best understood, applicant's new bulk section in the form of a laminate would be no different than a laminate bulk section not having the first slats placed in a different order. It is further noted that applicant acknowledges that shuffling the order of the first slats is known in the art to exist (line 3-4, pg. 10 of the arguments of 11/16/07 & line 8-13, pg. 12 of the arguments of 7/28/08).

Further, as best understood, the finished wood slats have substantially unnoticeable joining marks.

With regards to claim 10: Applicant prior art method discloses a first bulk section in the form of a rectangular block (10).

With regards to claim 12: Applicant prior art method, in view of Kertscher, would produce wood slats and a plurality of first slats having a thin rectangular shape.

With regards to claim 13, 15-17 and 21-28: PRODUCT-BY-PROCESS CLAIMS  
ARE NOT LIMITED TO THE MANIPULATIONS OF THE RECITED STEPS, ONLY THE  
FINAL RESULTING STRUCTURE IMPLIED BY THE STEPS

Determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. MPEP 2113.

However, the finished wood slats of applicant's prior art method, in view of Kertscher, would appear as the claimed finished slats.

With regards to claim 20: As per the modification of claim 27, the second parallel planes are generally perpendicular to the first parallel planes.

### ***Response to Arguments***

Applicant's arguments filed 7/28/08 have been fully considered but they are not persuasive.

Regarding figures 6, 9, and 10: Applicant argues that one skilled in the art of lamination would know that the "lines" of the top joined when viewed are not noticeable as the angle of the two joining pieces and the wood grain camouflage the joining marks, unlike the joining marks on the front face of the joined blocks. Applicant further argues that in figure 6 there are no joinder lines illustrated as the wood has been marked.

Examiner notes proposed figure 6 submitted 7/28/08 includes joinder lines. Examiner

disagrees with applicant that the marks would be not noticeable, Examiner submits pieces of wood that are joined with sections of wood removed as shown in figs. 4-6 will include a discontinuous wood grain pattern, thus accentuating the joint lines.

Applicant further argues that the objections to claims 20-21 should be withdrawn as "perpendicular" further limits "transverse". Applicant's arguments are not found persuasive. Merriam-Webster Dictionary defines transverse as: 1 : acting, lying, or being across : set crosswise 2 : made at right angles to the long axis of the body <a *transverse* section>.

Applicant further argues that shuffling the wood stats by turning the slats 180 degrees and reordering would be known to one of ordinary skilled in the art. Applicant further argues that the grain will vary throughout the width of the formed block therefore making the wood marks unnoticeable when cutting the block transversely. Examiner acknowledges Applicant's admission that is known to reshuffle wood slats. However, Examiner disagrees that cutting the block transversely would make the joining mark unnoticeable. If one were to rearrange the wood slats so as to vary the wood pattern, the joint lines would be accentuated as a break in the wood pattern would be present, thus making the joining marks noticeable. Note the disclosure doesn't support turning the slats 180 degrees. If this were the case, the laminated wood block would include joint lines on the top face that are discontinuous.

Applicant further argues that with respect to the product-by process claims (claims 22-23 and 27-28), one of ordinary skill in the art would recognize being "substantially unnoticeable" does not mean that traces indicating the ordinary joining

marks are non-existent. Applicant's arguments are persuasive with regards to claims 22-23 and 27-28. Accordingly, the rejection of claims 22-23 and 27-29 to Kertscher under 35 USC 102(b) has been withdrawn.

In response to applicant's argument that applicant's admitted prior art and Kertscher are not concerned with making the zigzag joining marks unnoticeable, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Applicant further argues that applicant's admitted prior art does not teach all the limitations of applicant's amended claims 7, 13, 22, and 23. Examiner disagrees, applicant discloses in the specification the steps of claim 7 are known in the prior art, excluding rearranging the slats in a different order the first to create a new laminated bulk section and cutting the laminated bulk section transverse to the a first parallel plane. However, applicant admits that rearranging wood slats is within the level of ordinary skill the art (lines 3-4, pg. 10 of the arguments of 11/16/07 & line 8-13, pg. 12 of the arguments of 7/28/08). In addition, Kertscher discloses forming a bulk section from wood slats and cutting transversely to a first plane (figs. 1 & 3; col. 4, lines 84-109).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was

within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

The objection of claim 10, 12, 24 and 27 has been withdrawn in view of the amendment filed 7/28/08.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JESSIE FONSECA whose telephone number is (571)272-7195. The examiner can normally be reached on M-F 7:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Canfield can be reached on (571)272-6840. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. F./  
Examiner, Art Unit 3633

/Robert J Canfield/  
Supervisory Patent Examiner, Art Unit 3635